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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,306	06/08/1999	PAUL BERKOWITZ	16296.705	6592

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SOLVANG, CA 93463

EXAMINER

MOORE, JAMES K

ART UNIT	PAPER NUMBER
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2686

15

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/328,306

Applicant(s)

BERKOWITZ ET AL.

Examiner

James K Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 14, 17, 18, 20-32, 36-43, 46, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18, 20-32, 36-43, 49 and 50 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 14 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed December 8, 2003 with regards to claims 1 and 14 have been fully considered but they are not persuasive.

Regarding claim 1, the applicant has amended the claim to overcome a 112, 2<sup>nd</sup> paragraph rejection by replacing "the circuitry coupled to the set of interfaces" with "the interface devices." However, this amendment results in the claim being anticipated by the Houde reference, as described below.

Regarding claim 14, it is not clear from the specification how the communication system would be constructed in order for communication between the circuitry coupled to the set of interfaces and the subscriber to take place entirely over a land line system. The six lines of the specification mentioning use of the invention with a cable network (see page 23) are not descriptive, there are no figures illustrating use of the invention with a cable network, and the reference provided by the applicant does not show that one of ordinary skill would understand how to construct the invention so that it can be used with a cable network.

***Claim Rejections - 35 USC § 112***

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 14, the specification does not adequately describe how communication between the circuitry coupled to the set of interfaces and the subscriber can take place entirely over a land line system.

***Claim Rejections - 35 USC § 102***

4. Claims 1-3, 6 and 7 are rejected under 35 U.S.C. 102(a) as being anticipated by Houde et al. (U.S. Patent No. 5,978,678).

Regarding claim 1, Houde discloses a method of modifying an existing telephone network (the PSTN). The method comprises coupling interface devices (switching nodes 14) to the telephone network. The interface devices are inherently coupled to circuitry coupled to radio transceivers that service mobile subscribers (16) that may be located in various geographic regions, and the mobile subscribers are each assigned to a geographic region. The interface devices are also coupled to circuitry (international gateway 50) that, when a subscriber (16(1)) is located in a region (the second country) other than a geographic region (the first country) to which the subscriber is assigned, routes a call with the mobile subscriber through a path including a radio transceiver (inherently coupled to a switching node 34) that serves the region (second country) in which the mobile subscriber is currently located and an interface device that serves the

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region (first country) to which the subscriber is assigned. The subscriber has a set of directory numbers (a home directory number and a temporary local directory number (TLDN)), and each call is associated with a directory number). For a call to the mobile subscriber, the interface devices, upon detecting that the mobile subscriber is located outside the mobile subscriber's home region, route the call (i.e., selection of a preferred long distance carrier) depending on instructions in a subscriber service profile (in an HLR). The instructions are associated with the directory number associated with the call. See Figures 1 and 3; col. 3, lines 10-39; col. 4, lines 3-27; and col. 5, line 1 through col. 6, line 4.

Regarding claim 2, Houde discloses all of the limitations of claim 1, and also discloses that the existing telephone network comprises a PSTN. See col. 5, lines 5-10.

Regarding claim 3, Houde discloses all of the limitations of claim 1, and the path between the radio transceiver (inherently coupled to a switching node 34) and the interface device (switching node 14) in the region (first country) to which the subscriber is assigned does not include the existing telephone network (PSTN). See Figure 1.

Regarding claim 6, Houde discloses all of the limitations of claim 1, and also discloses that the path between the inherent radio transceiver and the interface device (14) that serves the region to which the subscriber is assigned includes an interface (switching node 34) that serves the region in which the subscriber is located. See Figure 1.

Regarding claim 7, Houde discloses all of the limitations of claim 1, and also discloses that the path between the inherent transceiver and the interface device (14)

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that serves the region to which the subscriber is assigned includes a device (international gateway 50) that is coupled to the interface devices (14, 34) via bearer channels (voice trunk connections 20, 40) and control channels (signaling links 18, 38). See col. 4, lines 3-12.

***Claim Rejections - 35 USC § 103***

5. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houde et al. in view of well known prior art.

Regarding claim 4, Houde discloses all of the limitations of claim 1, but does not disclose that the path between the inherent radio transceiver and the interface device (14) that serves the region (first country) to which the subscriber is assigned includes the existing telephone network (PSTN). However, one of ordinary skill in the art at the time of the invention would have recognized that, depending upon the configurations of the communication networks of the first country and the second country, the most efficient routing path between the interface (switching node 14) receiving the call and the international gateway 50, or the most efficient routing path between the international gateway 50 and the interface (switching node 34) serving the mobile station, may include a path through the PSTN. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Houde, such that the path between the inherent radio transceiver and the interface device (14) that serves the region (first country) to which the subscriber is assigned includes the existing telephone network (PSTN), in order to route the call along the most efficient path.

Regarding claim 5, Houde discloses all of the limitations of claim 1, but does not disclose that the path between the inherent radio transceiver and the interface device (14) that serves the region (first country) to which the subscriber is assigned includes an E1 link. However, it was well known in the art at the time of the invention that E1 is a European communication standard that provides high-speed data transfer. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Houde, such that the path between the inherent radio transceiver and the interface device (14) that serves the region (first country) to which the subscriber is assigned includes an E1 link, in order to provide the network with the capability to transfer high amounts of data.

***Allowable Subject Matter***

6. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 17, 18, 20-32, 36-43, 46, 49 and 50 are allowed.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ken Moore, whose telephone number is (703) 308-6042. The examiner can normally be reached on Monday-Friday from 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314 (for Technology Center 2600 only)



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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ken Moore

*JKM*

5/27/04

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**